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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,616	02/21/2002	Andreas Wieck	101769-141/tesa AG 1527-C	9569

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EXAMINER

EGAN, BRIAN P

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 10/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/081,616

Applicant(s)

WIECK ET AL.

Examiner

Brian P. Egan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

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2. The specification lacks section headings and also fails to disclose a brief description of the drawings. The Examiner suggests arranging the specification with subject headings in the manner detailed above.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 8, 10-11, and 13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Greuse et al. (#5,250,336).

Greuse et al. disclose a protective material with punched shaped parts (Figs. 3-4) as well as a method of using the protective material (see Abstract) wherein a double sided adhesive tape is placed on top of the protective material (Fig. 1, #14) from which punch shaped parts are punched out by a kiss-cut punching tool (“die-cut” – Col. 4, lines 18-19), wherein the protective material comprises a colored polymer backing sheet having a top and a bottom face (note that the Examiner has defined the combination of layers #16 and #18 (the backing layer and release layer) as the polymer backing sheet – see Fig. 1). The backing sheet comprises a backing layer which itself may comprise colorants (Col. 7, lines 52-56) and further comprises an anti-adhesive dyed silicone layer along the top face of the backing sheet (Fig. 1, #16; Col. 3, lines 59-62; Col. 4, lines 1-2; Col. 7, line 64 to Col. 8, line 4) that is in contrast with the color of the backing layer (Col. 7, lines 56-62), the anti-adhesive coating being positioned on the same side of the backing

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layer as the adhesive tape (see Fig. 1). The color layer is applied over the full area of the backing layer (see Fig. 1; Col. 4, line 49-56).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4-7, 9, 12, and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greuse et al. (#5,250,336) in view of Higgins (#5,932,352).

Greuse et al. teach a protective material as detailed above. Although Greuse et al. fail to explicitly teach a coating density between 5 and 7 grams per square meter, Greuse et al. teach that the coating density may be modified depending on the desired color of the end product (Col. 5, lines 7-24; Col. 5, lines 31-35). Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified the coating density of the dyed silicone layer such that it fell within the Applicant's claimed range in order to attain a desired color for the end product. Furthermore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified the coating density of the silicone release layer such that it falls within the Applicant's claimed range, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Although Greuse et al. teach the use of a backing layer, Greuse et al. fail to explicitly teach that the backing layer is one of polyester, polystyrene, polyamide, or polyimide and also fail to explicitly teach the thickness of the backing layer.

Higgins, however, teach the use of a polymer backing sheet for a release film wherein the backing sheet may be formed from polyester (Col. 2, lines 16-18). The backing sheet, depending on the intended application, may range in thickness from 5 to 350 micrometers (Col. 8, lines 43-48). Higgins teaches the use of a polyester polymeric backing sheet in a release liner for the purpose of providing a substrate with improved processability and improved suppression of silicone debris production (Col. 1, lines 35-56). It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have combined the teachings of Greuse et al. and Higgins since each of the aforementioned references are analogous insofar as being directed at silicone release liners and are both concerned with minimizing silicone debris production.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified Greuse et al. to include a polyester backing sheet as taught by Higgins in order to provide a substrate with improved processability and improved suppression of silicone debris production.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Egan whose telephone number is 703-305-3144. The examiner can normally be reached on M-F, 8:30-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 703-308-4251. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

B. P. Eg
BPE 9/27/03

Harold Pyon
HAROLD PYON
SUPERVISORY PATENT EXAMINER
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9/29/03